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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/825,931	04/05/2001	Kimikazu Nagase	360842007600	3818
25227	7590	10/22/2003	EXAMINER	
MORRISON & FOERSTER LLP 1650 TYSONS BOULEVARD SUITE 300 MCLEAN, VA 22102			WALKE, AMANDA C	
		ART UNIT	PAPER NUMBER	
		1752		

DATE MAILED: 10/22/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Applicant No.	Applicant(s)
	09/825,931	NAGASE ET AL.
	Examiner Amanda C Walke	Art Unit 1752

— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 28 July 2003.
- 2a) This action is FINAL.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1,2,5,6,8-10 and 12-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1,2,5,6,8-10 and 12-17 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>6</u> | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 2, 5, 6, 8-10, and 12-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Ichikawa et al (EP 897795).

Ichikawa et al disclose a method of directly manufacturing a waterless lithographic printing plate comprising the steps of providing a support having coated thereon a thermosensitive layer and a silicon rubber layer, exposing the plate with laser beams and developing it (removing the imaged portions of the layer). The thermosensitive layer comprises dyes that absorb infrared or near-infrared light. The dyes should have a maximum absorption in the 400 to 1200 nm range, preferably the 700 to 900 nm range (page 3, line 42 to page 4, line 4). After exposure, the plate undergoes development, which is preferably includes dyeing with a dyeing solution comprising a visible dye (page 12, line 45 to page 13, line 15). In the examples of the reference, the dyeing solution comprises 0.2 % by weight of the visible dye. The dyes listed by the reference, Crystal Violet and Victoria Pure Blue, are specifically mentioned as being preferred by the present application. The reference further teaches that there is an after-treatment step of dyeing to aid in the confirmation of the image area formed by the development. After dyeing, the heat sensitive layer surface is evaluated by observing visually the condition of the dyed layer's image/non-image area boundary.

With respect to the present claim limitation requiring that the difference between the reflected absorption of the non-printing area which holds the ink-repelling layer and the reflected absorption of said printing area observed after dyeing of the printing plate at the absorption maximum wavelength of the dye in said dyeing solution is not less than 0.3 and not more than 2.0, the limitation requiring that the maximum dye absorption be within a certain range, and to the limitation requiring that that ratio A/B be a certain value, it is the position of the examiner that since the material of the reference comprises the same dyes having wavelengths within the preferred range of the present application, is dyed employing visible dyes taught by the present specification as being suitable for use in the invention of the reference, and appears to be made using the same method steps, that when made, the printing plate of the reference would inherently possess the presently claimed properties, especially given that the reference teaches that the image area/ non-image area boundary is able to be observed visually after dyeing.

With respect to the limitations of the method claims that contain the phrase "observed by the reflection method" or "observed by the transmission method", these are not positive method steps. These claims are claiming a method of manufacturing a printing plate which when made possesses certain properties that is desired may be observed by these methods and not actually adding a method step of observing the plate using either the transmission or reflection method. These claims are rejection under 102(b) for the reasons above.

***Response to Arguments***

3.     Applicant's arguments filed 7/28/2003 have been fully considered but they are not persuasive.

Applicant has argued that the examiner's assertion that the material of Ichikawa et al inherently possesses the presently claimed properties, specifically those requiring that the difference between the reflected absorption of the non-printing area which holds the ink-repelling layer and the reflected absorption of said printing area observed after dyeing of the printing plate at the absorption maximum wavelength of the dye in said dyeing solution is not less than 0.3 and not more than 2.0, the limitation requiring that the maximum dye absorption be within a certain range, and the limitation requiring that that ratio A/B be a certain value. To support his argument, applicant submitted a 1.132 declaration in which 2 samples of the reference were prepared and tested to demonstrate that they indeed do not possess the above properties. The examiner considered the declaration, but did not find it persuasive. The examiner cited the teaching of the reference which points to two dyes, Crystal Violet and Victoria Pure Blue, which are specifically mentioned as being preferred by the present application. These dyes were two of three preferred dyes listed within the body of the specification, and two of 4 total described by the reference as C.I. Basic Blue 1 is employed in the examples. However, the two dyes cited by the examiner are two of four total mentioned by the reference and are this specifically contemplated for use in the invention of the reference. It was the examiner's position as stated above, that since the material of the reference comprises the same dyes having wavelengths within the preferred range of the present application, is dyed employing visible dyes taught by the present specification as being suitable for use in the invention of the reference, and appears to be made using the same method steps, that when made, the printing plate of the reference would inherently possess the presently claimed properties, especially given that the reference teaches that the image area/ non-image area boundary is able to be observed

visually after dyeing. Therefore, the examples of the declaration are not persuasive as applicant has not employed either of the dyes pointed to by the examiner.

***Conclusion***

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

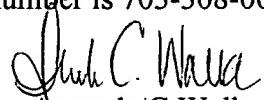
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amanda C Walke whose telephone number is 703-305-0407. The examiner can normally be reached on M-R 5:30-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Baxter can be reached on 703-308-2303. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

  
Amanda C Walke  
Examiner  
Art Unit 1752

ACW  
October 20, 2003

  
JANET BAXTER  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1700